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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,060	08/02/2001	Marty Steinberg	99997.023404	6179
7590	03/07/2007		EXAMINER CHAMPAGNE, DONALD	
Nancy J. Flint Hunton & Williams 1111 Brickell Avenue Miami, FL 33131			ART UNIT 3622	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/07/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/921,060	STEINBERG, MARTY	
	Examiner Donald L. Champagne	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 December 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 November 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-30-01, sheet 2 of 2 only.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. Applicant asked the examiner (p. 6 of the amendment filed on 4 December 2006) to certify the IDS's filed on 30 August 2001 and 21 October 2001. The second page (sheet 2 of 2) of the IDS filed on 30 August 2001 has been certified and made of record with this Office action. The other sheets of both IDS's have previously been certified and made of record in the Image File Wrapper. The examiner has been told that the certified IDS forms are available by order through Private PAIR. For information about the PAIR system, see <http://pair-direct.uspto.gov>. For more help with Private PAIR, call the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-11 and 14-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggleston et al. (US006061660A).

5. Eggleston et al. teaches (independent claims 1, 16, 22 and 23) method and system for managing purchasing incentives offered to consumers, the method comprising:

receiving information on membership in one or more loyalty programs of offering companies and organizations from a plurality of consumers (col. 12 lines 22-28 and col. 1 lines 30-31);

receiving a query from at least one consumer for available purchasing incentives for a product or service that are available due to the consumer's participation in the one or more loyalty programs (col. 12 lines 49-53 and col. 16 lines 30-32, and para. 14 below);

processing the query and transmitting information relating to the availability of purchasing incentives in response to the query of the consumer (col. 12 lines 40-48).

6. Eggleston et al. also teaches at the citations given above claims 6, 15 and 21.
7. Eggleston et al. also teaches: claims 2-5, 8 and 17-20 (col. 14 lines 7-25, where for claims 5 and 18 querying *sponsor database 202* reads on transmitting the query to a plurality of offering companies and organizations); claims 9-11 (col. 18 lines 46-57); and claim 14 (col. 15 lines 8-12).
8. Claims 7, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable Eggleston et al. (US006061660A).
9. Eggleston et al. does not teach (claim 7) storing the query in a searchable database. Because the queries would be useful marketing information for the offering companies/ sponsors, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that the query be stored in searchable *consumer database 200*.
10. Eggleston et al. does not teach (claim 12) that at least some of the marketing information is transmitted anonymously. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to guard the privacy of consumers by anonymous dissemination of consumer data. Because it is obvious to follow common practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that at least some of the marketing information is transmitted anonymously.
11. Eggleston et al. does not teach (claim 13) offering compensation to the querying consumer if no incentive is available in response to the query. Because it would enhance customer service, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that compensation be offered if no incentive is available in response to the query.

Response to Arguments

12. Applicant's arguments filed with an amendment on 4 December 2006 have been fully considered but they are not persuasive.

13. Applicant argues (p. 10, with respect to claim 1),

“First, Eggleston does not disclose that the host system receives information on membership in one or more loyalty programs of offering companies and organizations from a plurality of consumers. The only information that Eggleston discloses as received from consumers is registration information, which occurs before the consumer is permitted to participate in the incentive programs on the host system website.”

(Emphasis added.)

First, the limitation is to “receives information”; there is no “host system receives” limitation in claim 1. Second, the examiner interpreted the claim to mean “receives information ... from a plurality of consumers”. The reference teaches consumers receiving information on how to become a loyalty program member (col. 12 lines 22-28 and col. 1 lines 30-31), which reads on the limitation.

14. Applicant also argues,

“Further, Eggleston does not disclose *receiving a query from at least one consumer for purchasing incentives for a product or service that are available due to the consumer's participation in the one or more of the loyalty programs*, as claimed in claim 1 as amended.” (Middle of p. 11, emphasis added.)

The reference teaches that a query is received from the consumer, and the reply is transmitted back to the consumer, through *consumer site 192*. That shares space in *data storage device 178* with all the incentive information (col. 11 line 66 to col. 12 line 18), especially including the *sponsor database 202* where the consumer gets incentive/loyalty program information (col. 16 lines 30-32). All of the incentive information is available only through *consumer site 192*, which is accessible only to member consumers, which reads on the subject limitation.

15. Applicant also argues,

"However, the consumer in Eggleston is eligible for a "prize" or "award" only if the consumer participates in an incentive program of a sponsor and accordingly "wins" the "prize" or "award". See col. 13 lines 51-54; col. 40 lines 36-37. There is no disclosure in Eggleston of purchasing incentives that are available to a consumer based on the consumer's "participation" in a loyalty program of an offering company or organization." (Bottom of p. 11.)

The reference teaches *discount coupon programs* (col. 1 lines 30-31), which reads on purchasing incentives that are available to a consumer based on the consumer's "participation" in a loyalty program of an offering company or organization.

16. Applicant repeats the same arguments in pp. 12-18 inclusive.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.

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20. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
22. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
23. Applicant may have after final arguments considered and amendments entered by filing an RCE.
24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

27 February 2007

Donald L. Champagne
Primary Examiner
Art Unit 3622

DONALD L. CHAMPAGNE
PRIMARY EXAMINER